

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Ron S. Israeli, et al.
U.S. Serial No. : Not Yet Known
Filed : June 6, 1995
For : PROSTATE-SPECIFIC MEMBRANE ANTIGEN AND USES
THEREOF

1185 Avenue of the Americas
New York, New York 10036
June 6, 1995

Honorable Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Sir:

PRELIMINARY AMENDMENT

Please amend the subject application as follows.

In the Specification:

On page 1, lines 8-11, please delete "This application is a continuation-in-part of United States Application Serial No. 07/973,337, filed on November 5, 1992, the contents of which are hereby incorporated by reference."

On page 1, lines 8-11, please insert "This application is a continuation application of U.S. Serial No. 08/403,803, filed March 17, 1995, and a continuation of PCT International Application No. PCT/US93/10624, filed November 5, 1993; which is a continuation-in-part of U.S. Serial 07/973,337, filed November 5, 1992, the contents of which are hereby incorporated by reference."

In the Claims:

Please cancel claim 78 without prejudice to applicants' right to

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pursue the subject matter of the cancelled claim in a later filed continuation or divisional application.

Please amend claims 59, 77, 79, and 84 by adding the underlined material and deleting the bracketed material as follows:

- 59. (Amended) A method of suppressing or modulating metastatic ability of prostate tumor cells, prostate tumor growth or elimination of prostate tumor cells, comprising introducing a DNA molecule of claim 2 [encoding a prostate specific membrane antigen] operatively linked to a 5' regulatory element coupled with a therapeutic DNA into a tumor cell of a subject, thereby suppressing or modulating metastatic ability of prostate tumor cells, prostate tumor growth or elimination of prostate tumor cells.--
- 77. (Amended) A therapeutic vaccine for preventing human prostate tumor growth or stimulation of prostate tumor cells in a subject, comprising administering to the subject an effective amount of the cells of claim 74, which expresses or is capable of expressing a prostate specific membrane antigen, and a pharmaceutical acceptable carrier, thereby preventing the tumor growth or stimulation of tumor cells in the subject.--
- 79. The method of claim [78] 90, wherein the primers are derived from a nucleic acid molecule encoding a prostate specific membrane antigen.--
- 84. (Amended) A method of abrogating mitogenic response due to transferrin, comprising introducing a DNA molecule of claim 2 [encoding prostate specific membrane antigen] operatively linked to a 5' regulatory element into a tumor cell, the expression

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of which gene is directly associated with a defined pathological effect within a multicellular organism, thereby abrogating mitogen response due to transferrin.--

Please add new claims 90-92 as follows:

- 90. (New) A method of detecting micrometastatic tumor cells of a subject, comprising performing polymerase chain reaction (PCR) on tissue, blood fluid, or cells of the subject using primers that hybridize with the nucleic acid molecule of claim 1, thereby detecting micrometastatic tumor cells of the subject.--
- 91. (New) A method of detecting a nucleic acid molecule encoding a prostate specific membrane antigen comprising performing polymerase chain reaction (PCR) on a mammalian tissue or cell using primers that hybridize with the nucleic acid molecule of claim 1, thereby detecting a nucleic acid molecule encoding a prostate specific membrane antigen.--
- 92. (New) The method of claim 1, wherein the nucleic acid molecule is DNA, RNA or cDNA.--

REMARKS

The subject application is a continuation application of U.S. Serial No. 08/403,803, filed March 17, 1995, and a continuation of PCT International Application No. PCT/US93/10624, filed November 5, 1993; which is a continuation-in-part of U.S. Serial 07/973,337, filed November 5, 1992.

The parent application U.S. Serial No. 08/403,803, filed March 17, 1995 is still pending. Thus, the parent application is

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pending today and the subject Continuation application is copending therewith for purposes of 35 U.S.C. §120.

Applicants have hereinabove cancelled claim 78 without prejudice to applicants' right to pursue the subject matter of the cancelled claims in a later filed continuation or a divisional application. Further, applicants have hereinabove amended claims 59, 77, 79 and 84, and added new claims 90-92. Accordingly, claims 1-77 and 79-92 are pending in the subject application.

Support for claim 77 may be found inter alia in the specification as follows: page 37, lines 5-9; page 66, line 5-35; and Figures 11, and 17A-17C. Support for claims 90 - 92 may be found inter alia in the specification as follows: page 20, lines 4-11; page 39, line 26 - page 40, line 2; page 86, line 7 - page 87, line 16; page 91, lines 5-32 and SEQ ID NO's 1 and 2. Applicants have amended claims 59, 79, and 84 to correct their dependencies. Applicants maintain that these amendments to the specification and claims do not raise an issue of new matter and accordingly request that the amendments be entered.

Applicants maintain that the claims now pending in the subject application define patentable subject matter. Applicants earnestly solicits favorable action on the merits and allowance of claims 1-76 and 79-92, which are now pending.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

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No fee, is deemed necessary in connection with the filing of this Preliminary Amendment. However, if any fee is necessary, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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